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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,636	03/29/2004	Dennis McDevitt	022956-0692	2385
21125 7590 05/19/2010 NUTTER MCCLENNEN & FISH LLP SEAPORT WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604				
EXAMINER SCHNEIDER, LYNNSY M				
ART UNIT 3733		PAPER NUMBER		
NOTIFICATION DATE 05/19/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

doctet@nutter.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/811,636

Applicant(s)

MCDEVITT ET AL.

Examiner

LYNN S. SCHNEIDER

Art Unit

3733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 May 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733

/L. S./
Examiner, Art Unit 3733

Continuation of 11, does NOT place the application in condition for allowance because: The arguments regarding the rejection over Johanson in view of Sander are not persuasive.

In response to Applicant's statement that there is no motive for the Examiner's rationale to modify Johanson with Sander, Examiner would like to point out that Sander teaches that prior art bioabsorbable pins must have pre-drilled holes into which they are inserted (col. 5, lines 10-12), but the tips 104 and 201 of Sander make it possible to directly implant a bioabsorbable pin (col. 5, lines 23-32). Therefore, the pin has the advantage of being bioabsorbable with the added advantage of being directly implanted into bone (col. 5, lines 13-15). Therefore, Sander specifically teaches that it is advantageous to modify a prior art bioabsorbable pin that is designed to be implanted into a pre-drilled hole (such as the pin of Johanson) to have a separable distal tip member or a harder material so that the bioabsorbable pin can be directly implanted into the bone. Such a modification improves the device of Johanson because it allows the surgeon to implant the pin without the additional step of pre-drilling the hole.

In response to Applicant's argument that Johanson was specifically designed to avoid drilling into bone, Examiner would like to point out that Johanson discloses that the pin can be threaded into bone in col. 3, lines 14-18).

In response to Applicant's argument that Johanson specifically teaches deploying its expandable sleeve into a pre-formed hole to avoid imparting a drilling or driving force on the bone, and that the Examiner's proposed modification would both circumvent the intended purpose of Johanson and would be completely contrary to the teachings of Johanson, Examiner would like to point out that Johanson discloses pre-drilling of the bone. Therefore, the bone does, in fact, experience a drilling or driving force in the step of pre-drilling. The modification of Johanson to include a separable distal tip of a harder material merely allows the surgeon to perform the drilling and inserting steps at one time, rather than separately. Therefore, the modification does not impose any undue stresses on the bone and does not deviate from the disclosure of Johanson.

In response to Applicant's argument that the proposed modification renders the prior art invention unsatisfactory for its intended purpose, Examiner would like to point out that the modification does not prevent the bioabsorbable pin of Johanson from being used for its intended purpose. The addition of a separable distal tip does not prevent the pin from being inserted into a pre-drilled hole. The pin can still be used as disclosed with the added advantage of being capable of being used in a situation in which it is desirable to perform the drilling and inserting steps at the same time.

The Applicant does not present arguments regarding the specific combinations of references for the remaining 35 U.S.C. rejections, but rather relies on the arguments regarding Johanson and Sander. Therefore, the arguments regarding the remaining 35 U.S.C. 103 rejections are not persuasive for the same reasons stated above.